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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/521,005	03/07/2000	Michael R. Pallesen	M-8036 US	1151

33031 7590 10/18/2006

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EXAMINER	
BLECK, CAROLYN M	

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/521,005	PALLESEN ET AL.	
	Examiner	Art Unit	
	Carolyn M. Bleck	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12,14-24 and 26-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12,14-24 and 26-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the response to non-final office action filed on 1 August 2006. Claims 1-12, 14-24, and 26-36 are pending. No claims have been amended.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-12, 14-24, and 26-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Background of the Invention (pages 1-2 of Applicant's originally filed specification) in view of Kennedy (5,787,453), for substantially the same reasons given in the previous Office Action (mailed on 27 January 2006).

(A) Claims 1-12, 14-24, and 26-36 have not been amended, and are therefore rejected for the same reasons given in the previous Office Action (mailed on 27 January 2006).

Response to Arguments

4. Applicant's arguments filed 1 August 2006 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear in the response filed on 1 August 2006.

(A) At pages 2-3 of the response filed on 1 August 2006, Applicant argues that the Applicant's Background of the Invention fails to teach an insurance product rate expression.

First, Applicant argues that the phrase "product rate expression" is not recited in Applicant's Background of the Invention. In response, while the Examiner recognizes that this particular phrase may not appear in the Background of the Invention, the Examiner respectfully submits that a form of a "product rate expression" is disclosed at page 2, lines 5-12 of the originally filed specification. For example, this paragraph discloses using mathematical expressions to calculate insurance product rates. It is unclear how this is not a form of a product rate expression. It appears that this is an expression that is used to calculate an insurance product rate, and is thus clearly a form of a "product rate expression."

Second, the Examiner respectfully submits that Applicant has failed to provide a specific definition of a product rate expression. The Applicant argues that the claimed "product rate expression" is a specific term used to describe a novel aspect of the Applicant's invention and provides citations from Applicant's specification that define this novel feature. In response, it is respectfully submitted that the specification citations relied upon by the Applicant do not provide a positive definition of the claimed "product

rate expression." Instead, the cited passages use non-commital language that only describes the features which "can be" or "are preferably" included in the claimed "product rate expression" in various embodiments. Such descriptions fail to define the required features of the "product rate expression". As such, the Examiner has given the claim language the broadest interpretation and has applied art accordingly.

Third, Applicant also argues that the mathematical expressions and data are encode into the programming for the insurance product application, and thus cannot be considered to be Applicant's claimed "product rate expression." The Examiner respectfully submits that because there is no specific definition for the phrase "product rate expression" that Applicant's disclosure in the Background of the Invention can be considered to be a form of a "product rate expression" regardless of if the mathematical expression is encoded in the programming for the insurance product application.

(B) At pages 3-4 of the response filed on 1 August 2006, Applicant argues that the applied prior art fails to teach the features of claims 1, 15, 26, and 27.

In response, the Examiner respectfully submits that the applied references teach a product rate information cache storing product rate information. Applicant's Background of the Invention teaches a web server or application having mathematical expressions and data encoded into the programming for the insurance product application for calculating insurance product rates (page 2, lines 5-10). This is considered to be a form of a "product rate information cache." Applicant does not provide a definition of the product rate information cache. Furthermore, it is noted that

Kennedy teaches a database. Thus, the combination of Applicant's Background of the Invention and Kennedy teaches both a product rate information cache and a database.

Applicant argues that the product rate information cache is clearly distinct from the database. The Examiner respectfully submits that the two components of the system are not claimed as being separate. It is noted that the features upon which applicant relies (i.e., distinct system components) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(C) At pages 4-5 of the response filed on 1 August 2006, Applicant argues that Examiner has failed to show some suggestion or motivation to combine the Background and the Kennedy references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner

has provided a motivation directly from the references themselves, namely the Kennedy reference.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

7. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(571) 273-8300	[Official communications]
(571) 273-8300	[After Final communications labeled "Box AF"]
(571) 273-6767	[Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.

CB
October 4, 2006

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER